



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

ID

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/376,774	08/17/99	FUNG	D6087

HM12/0829

DR BENJAMIN ADLER
MCGREGOR & ADLER LLP
8011 CANDLE LANE
HOUSTON TX 77071

EXAMINER

ZARA, J

ART UNIT

PAPER NUMBER

1635

4

DATE MAILED: 08/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/376,774

Applicant(s)

Fung et al.

Examiner

Zara, Jane

Group Art Unit

1635



- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-28 _____ is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-28 _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

File

Art Unit: 1635

DETAILED ACTION

Claims 1-28 are pending in the instant application.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, drawn to methods and compositions for achieving sustained gene expression under control of a heat or light inducible promoter, classifiable in class 435, subclass 455.
- II. Claim 4, drawn to a recombinant vector pDATE-x, classifiable in class 435, subclass 320.1.
- III. Claims 5-11, drawn to methods and compositions for treating local and metastatic breast and ovarian cancer comprising the administration of the multicomponent vector pRIBs-X, classifiable in class 514, subclass 44.
- IV. Claims 12-16, drawn to methods and compositions for treating local and metastatic prostate cancer comprising the administration of the multicomponent vector pRIPs-X, classifiable in class 514, subclass 44.
- V. Claims 17-23, drawn to methods and compositions for treating local and metastatic breast and ovarian cancer comprising the administration of the multicomponent vector pHIBs-X, classifiable in class 514, subclass 44.

Art Unit: 1635

- VI. Claims 24-28, drawn to methods and compositions for treating local and metastatic prostate cancer comprising the administration of the multicomponent vector pHIPs-X , classifiable in class , subclass .

The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I and III-VI are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Group I and III-VI comprise steps which are not required for or present in the methods of the other groups. The methods of each group are practiced with materially different starting materials and are for materially different purposes. Thus, the operation, function and effects of these different methods are different and distinct from each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

The inventions of Group II and Groups I and III-VI are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The operation, function and effects of the vectors are completely different and distinct from each other, and furthermore, the operation, function and effects of the methods of Groups I and III-VI are completely different and distinct from the operation, function and effects of the product of Group II. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Art Unit: 1635

Inventions III and IV and V and VI are biologically and functionally different and distinct from each other and thus one does not render the other obvious. The methods of Groups III, IV, V and VI comprise steps which are not required for or present in the methods of each other's groups, and the methods of each group are practiced with materially different starting materials. Furthermore, the methods of Groups IV and VI are for materially different purposes than those of Groups III and V. Thus, the operation, function and effects of these different methods are different and distinct from each other. Therefore, the inventions of these different, distinct groups are capable of supporting separate patents.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Benjamin Adler on or about August 28, 2000 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

Art Unit: 1635

amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

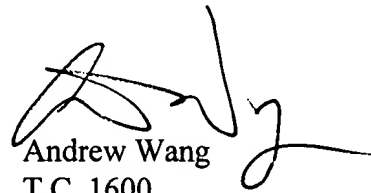
Conclusion

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jane Zara** whose telephone number is **(703) 306-5820**. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. George Elliott, can be reached on (703) 308-4003. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

JZ

August 28, 2000


Andrew Wang
T.C. 1600
Patent Examiner